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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/690,426	10/17/2000	David S. Cortright	MCS-020-99	3341

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EXAMINER

TRAN, LAMBERT L

ART UNIT	PAPER NUMBER
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2142

DATE MAILED: 08/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application N .

09/690,426

Applicant(s)

CORTRIGHT ET AL.

Examiner

Lambert L. Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 17 October 2000.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Action is in response to the application filed on 17 October 2000.

#### ***Priority***

2. No claim for priority has been made in this application.

#### ***Drawings***

3. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

- a. Reference 163 (Page 10, Lines 21 and 31).
- b. Reference 164 (Page 10, Lines 22 and 25).
- c. Reference 165 (Page 10, Line 27).
- d. Reference to step 416 (Page 14, Line 8).
- e. Reference to step 522 (Page 17, Line 4).

4. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Reference 192, 193, 194 of Figure 1. A proposed drawing correction, corrected drawings, or amendment to the

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specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(4) because:
  - a. Reference character “520” of Figure 5A and 5B has been used to designate both “Mark Text With Newsgroup Icon” and “Is Address An Invalid Email Address Or An Internet Address” blocks.
  - b. Reference character “524” of Figure 5B has been used to designate both “Mark Text With ‘TEXT’ Icon” and “Is Address A Valid Email Address Not Found To Match Any Contact List” blocks.
7. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
9. Claim 9 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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10. Referring to claim 9, “*perform the act of determining*” is unclear because in the claim, user is prompted to “*instructs the computer to perform the act of determining*” while “*said act of determining*” is already performed “*whenever the user establishes a correspondence with said one or more servers*”. Clarification or modification is required. The claim construction and the claim language in this claim are so complex and unclear. Examiner suggests to reformat this claim so that the user interactive portion can easily be followed.

11. In regards to claim 10, claim 10 recites the limitation “*where the acts of checking and marking these email addresses is postponed until processor background cycles can be used*”. It is unclear what this limitation is describing. The term “processor background cycles”, although used in the Specification but not defined. Examiner suggests clarification of this term so as it is not be confused with “processor cycles”, which is a hardware term and “background process”, which is mostly a software mechanism.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

13. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Spencer et al., U.S. Patent No 6349299, hereinafter referred to as Spencer, in view of Holtz, U.S. Patent No 6433800.

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14. Referring to claim 1, 24, 25, Spencer discloses a System And Method For Storing Electronic Contact Information Into An Electronic Address Book, wherein *a computer-implemented process for allowing a user to manipulate an email address contained in the preview pane or full message window of an email message of an email program as an object* [see Spencer, ABSTRACT, Figure 4, col.9, lines 6-13), *comprising using a computer to perform the following acts:*

*Identifying/recognizing an entry in the preview pane or full message window of an email message as an email address* [see Spencer, col. 5, lines 13-19);

*checking the email address against addresses in one or more contact databases* [see Spencer, col. 6, lines 14-48, and col. 8, lines 31-42);

*and*

*upon selection of the indicator by the user, allowing the user to manipulate the email address as an object* [see col. 7, lines 8-31, col. 8 7, lines 8-31, col. 8, lines 46-53]

However, Spencer does not disclose:

*marking the email address with an adjacently placed indicator;*

In the same field of endeavor, Holtz reference discloses graphical action invocation method providing iconic representations of actions available to be performed upon an object of a particular data type, such as address of an email message [see Holtz, ABSTRACT, and col. 3, lines 8-10, col. 3, lines 13-15]. An ordinary artisan in the art at the same time the invention was made, would have been motivated to look to a way to reduce the operation time on maintaining email address [see Spencer col. 1, lines 45-53].

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15. Accordingly, it would have been obvious to one of ordinary skill in the software programming art at the time the invention was made to have incorporated Holtz's teachings of graphical action invocation method through iconic presentation [see Holtz, col. 2, lines 55-64] with the teachings of Spencer's, for the purpose of providing a system that is more intuitive, ease of user interaction with the computer [see Holtz, col. 1, lines 63-65].

16. As per claims 24 and 25, these claims describe computer code and a system that implement the method of claim 1. They are rejected using the same rationale.

17. In regards to claim 2, Spencer discloses:

*finding at least one field in the preview pane or full message window containing an email message header of the email message containing one or more email addresses [see col. 4, lines 19, col. 4 lines 56-60]; and parsing at least one email address from the at least one email address field [see col. 3, lines 51-65, col. 5, lines 13-19].*

18. In regards to claim 3, Spencer discloses:

*reviewing each email address to determine if it is contained in a contact database, wherein a contact database is a set of stored contacts and corresponding addresses [see col. 6, lines 14-48, col. 8, lines 31-53].*

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19. In regards to claim 4, Spencer discloses an Electronic address book interface module [see Spencer, figure 2, col. 6, lines 25-35]. Spencer taught that the interface module allows user to track (determine) information about contacts, in other words:

*determining if the address corresponds to a single contact in the contact list;*

*determining if the address corresponds to a mailing list in the contact list;*

*determining if the address corresponds to a newsgroup address in the contact list;*

*determining if the address corresponds to an invalid email address or internet address;*

*determining if the address corresponds to a valid email address not found to match any addresses in the contact list.*

For this rationale, claim 4 is rejected.

20. In regards to claim 5, Spencer discloses the Electronic address book interface module running over a network as in a client-server system [see Spencer col. 12, lines 61-65]. Since the interface module allows user to track (determine) information about contacts in a client-server environment, it is also:

*determining if the address corresponds to an address in a contact list of at least one*

*server whenever it is determined the address is a valid email address not found to match*

*any address in the contact list.*

For this rationale, claim 5 is rejected.

21. In regards to claims 6-8, and 12-14, Spencer-Holtz taught the use of iconic presentation, the parsing and tracking of email addresses. Furthermore, Holtz also discloses an icon generator



[see Holtz, figure 5, col. 6, lines 9-16]. Thus, appending icons to specific addresses and addresses entities are taught by Holtz's iconic presentation and Spencer's database matching [see Spencer, col. 8, lines 31-42], identifying and verification of contacts [see Spencer, col. 4, lines 8-19, col. 4, lines 56-60, col. 6, lines 14-32, col. 6, lines 52-53] in a computer-networking environment. The uses of icons and non-text images are also disclosed in Spencer's invention even though they were not listed out in specific [see Spencer, col. 4, lines 20-36]. However, Spencer clearly states: "... icons or pictures may preferably be stored in the electronic address book database and may therefore be extracted" [see Spencer, col. 4, lines 33-35, and figure 1].

22. In addition, Spencer discloses: "The Electronic Address Book Interface Module may comprise any electronic address book programs" [see Spencer, col. 6, lines 28-30, and figure 2]. As well known in the art, any modern electronic address book programs would contain features such as mailing lists, detection of invalid email addresses, autofilling addresses from database. These features are the foundation of claims elements of the claims in this group (claims 6-8, 12-14) in conjunction with the icons elements.

23. Claim 9, as understood, presents user with an address flagging capability and user interactive capability. Spencer-Holtz discloses user interactivity in a networking environment [see Spencer, col. 2, lines 10-15, col. 12, lines 61-65], and [Holtz, col. 6, lines 58-67].

24. In regards to claim 10, Spencer-Holtz taught *wherein the act of identifying an entry in the preview pane or full message window of an email*

*message as an email address in an incoming email message comprises initially appending an icon representing an indeterminate indicator to all email addresses in the header that are not in a "From" address field, by way of parsing predefined label (from) and iconic presentation of an address [see Spencer, col. 4, lines 51-54, see Holtz, col. 3, lines 8-10].*

25. In regards to claim 11, Spencer-Holtz discloses *wherein the indeterminate icon appended to addresses in the email header that are not in the From address field is replaced with an appropriate icon when the checking and marking acts are performed by parsing unrecognized labeled values and iconic presentation of addresses [see Spencer, col. 5, lines 27-29, see Holtz, col. 3, lines 8-10].*
26. In regards to claim 15, Spencer-Holtz discloses *wherein the act of manipulating comprises one of moving, deleting, or copying the object [see Spencer, col. 11, lines 1-14, see Holtz, col. 3, lines 36-41].*
27. In regards to claim 16, Spencer-Holtz discloses *wherein the act of selecting an indicator comprises an act of selecting the indicator via an activation action associated with an input device [see Spencer, col. 7, lines 16-22, see Holtz, col. 4, lines 62-67].*
28. In regards to claim 17, Spencer-Holtz discloses *the act of allowing a user to open an*

*entry in the contact database associated with the address via an activation action associated with an input device* [see Spencer, col. 7, lines 16-22, col. 8, lines 31-42].

29. In regards to claim 18, Spencer-Holtz discloses *the act of prompting a user to create an entry associated with the address in the contact database via an activation action associated with an input device whenever such an entry does not already exist in the contact database* [see Spencer, col. 8, lines 37-42].
30. In regards to claim 19, Spencer-Holtz discloses *the act of selecting an indicator further comprises an act of displaying an appropriate contextual menu depending on the type of indicator associated with said address* [see Holtz, col. 3, lines 36-41].
31. In regards to claim 20, Spencer-Holtz discloses *the act of displaying an appropriate contextual menu further comprises adding an email address to a user's contact list and wherein an email address is added to the user's contact data base upon selection of the menu item* [see Spencer, col. 7, lines 23-31].
32. In regards to claims 21, Spencer-Holtz discloses *wherein the user has an option to open a window containing editable content associated with an email address if a contact who sent the email message is in the user's contact data base* [see Spencer, col. 6, lines 24-32, col. 8, lines 31-37].

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33. In regards to claim 22, Spencer-Holtz discloses *the act of using a computer to open an item associated with the email address after looking up the item in one or more contact databases when the user double clicks on the adjacently placed indicator* [see Spencer, col. 6, lines 24-32, col. 8, lines 31-37, Holtz, col. 3, lines 8-10, Holtz, col. 4, lines 62-67].
34. In regards to claim 23, Spencer-Holtz discloses *prompting the user to create an item associated with said indicator if the address was manually entered or captured from a server* [see Spencer, col. 6, lines 45-48, Holtz, col. 3, lines 8-10, Holtz, col. 6, lines 58-67].
35. Since all the claims limitations were disclosed by the combination of Spencer-Holtz, claims 1-25 are rejected.
36. Claims 1-3, 12, 15, 18, 20, 24 and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Teri Battles, "Tips For Using Yahoo Email", dated January 17, 1999, hereinafter referred to as Yahoo Mail, in view of Nielsen, U.S. Patent No 6405243.
37. Yahoo Mail features include:  
*marking the email address with an adjacently placed indicator; and*  
*upon selection of the indicator by the user, allowing the user to manipulate the selection of the indicator by the user, allowing the user to manipulate the email address as an object.* [see Yahoo Mail, page 2, lines 1-9]

38. However, Yahoo Mail does not explicitly *identifying an entry in the preview pane or full message window of an email message as email addresses*; nor does it explicitly *checking the email address against addresses in one or more contact databases*.

39. In the same field of endeavor, Nielsen discloses a method and system for updating email addresses that identifying the email address and search the databases for contact [see Nielsen, col. 3, lines 29-45, col. 4, lines 66-67, col. 5, lines 11-21, col. 6, lines 40-55]. An ordinary artisan in the art at the same time the invention was made, would have been motivated to look to a way to reduce the operation time on maintaining email addresses in Yahoo Mail because operation time in working with email was an inherent concern to one of ordinary skill in the art.

40. Accordingly, it would have been obvious to one of ordinary skill in the software programming art at the time the invention was made to have incorporated Nielsen's teachings of identifying email addresses and searching the contact databases into Yahoo Mail for the purpose of providing a system that is more responsive, less user interaction thus saving valuable time for user.

41. For the rationale set forth above, claims 1-3, 12, 15, 18, 20, 24 and 25 are rejected.

### ***Conclusion***

42. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Reed et al., U.S. Patent No 6345288, discloses transfer of metadata and method permits intelligent processing of information using object oriented processing.

- b. Huang et al., Pub. No U.S. 2003/0097361 A1, discloses message center based desktop systems.
- c. Dieterman, U.S. Patent No 6393464, discloses methods for creating lists of electronic addresses that are sent or received.
- d. Taylor et al., U.S. Patent No 6147773, discloses method and structure to allow synchronization between files residing on different computers.
- e. Lange et al., U.S. Patent No 6163794, discloses network system extensible by users.
- f. Hertzog et al., Pub. No 2003/0069874 A1, discloses method and system to automate the updating of personal information within a personal information management.
- g. BSC Information Technology: "Outlook For Windows 95 Address Book", dated January 31, 2000, discloses address book usage and management in Microsoft's Outlook product.

43. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Lambert L. Tran whose telephone number is (703) 305-4663. The examiner can normally be reached on 9AM - 5PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Powell can be reached on (703) 305-9703. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 746-7239 for regular communications and (703) 746-7238 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-9700.

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August 6, 2003

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